

REMARKS

Reconsideration and allowance in view of the following remarks are respectfully requested.

Claims 1-9 remain pending in the present application.

I. Rejection of the Claims Under 35 U.S.C. § 251

Claims 1-9 stand rejected under 35 U.S.C. § 251 as being broadened in a reissue application filed outside the two year statutory period. Applicant respectfully traverses this rejection for the reasons presented below.

The present application was filed on December 13, 1999 and claims priority from then co-pending application no. 08/702,107 (“the ‘107 application”), which was filed August 23, 1996. It should be noted that the August 23, 1996 filing date of the ‘107 application is within the two year statutory period measured from the issue date of the patent under reissue, i.e., U.S. Patent No. 5,343,878 (“the ‘878 patent”) issued September 6, 1994. A copy of the filing receipt of the present application indicating its status as a continuation from the ‘107 application is enclosed.

The Examiner’s attention is directed to M.P.E.P. § 1412.03, page 1400-18 (August 2001, 8th edition). The section beginning on this page of the MPEP entitled, “When a Broadened Claim Can be Presented”, sets forth the conditions when a broadening claim can be presented after the two year period. According to this section, “if intent to broaden is indicated in a parent reissue application within the two years, a broadened claim can be presented in a continuing reissue application after the two year period.” Applicant respectfully submits that the parent reissue application (the ‘107 application) indicated an intent to broaden by virtue of the addition of broadening claims 4-9 in a Preliminary Amendment accompanying that application. Because the present application is a continuing application from this parent application, the addition of broadening claims 4-9 is proper.

For the reasons presented above, applicant submits that claims 1-9 are proper under 35 U.S.C. § 251. Accordingly, applicant respectfully requests that the above rejection of claims 1-9 be withdrawn.

II. The Reissue Oath/Declaration

The Examiner alleges that the reissue oath/declaration is defective and claims 1-9 stand rejected as being based on a defective reissue oath/declaration. The Examiner has set forth the following two reasons why the reissue oath/declaration is defective: (1) the error relied upon in support of the reissue application is not an error upon which a reissue can be based; and (2) there is no indication that the errors being corrected in the reissue application arose without any deceptive intent. Applicant respectfully traverses this rejection for the reasons presented below. Each basis for the Examiner's indication that the reissue oath/declaration is defective are discussed in turn.

A. Error Not Correctable by Reissue

The Examiner alleges that it is improper in a reissue application to broaden the claims if the broadened claims encompass a modality for distending frontal portions of the neck beyond the pressure application modality disclosed in the specification. Applicant respectfully disagrees.

First, the rules and M.P.E.P sections cited by the Examiner do not support this conclusion. 37 C.F.R. § 1.175(a) and M.P.E.P. § 1414 set forth the content requirements of the reissue application. There is nothing in either of these two citations that address what the broadening claims can and cannot encompass. The reissue declaration of the inventor, Dr. Mark Sanders, indicates that U.S. Patent No. 5,343,878 is partly inoperative by having claimed less than what the applicant has the right to claim. Applicant submits that this identification of the error in the '878 patent meets the requirements of 37 C.F.R. § 1.175(a) and M.P.E.P. § 1414.

Second, it is well settled that an applicant has the burden of providing an enabling disclosure and of disclosing the best mode of practicing the invention, and does not have the burden of disclosing each and every mode capable of practicing the invention. The present invention can be summarized as a medical treatment of upper airway disorders that includes

distending the frontal portions of a patient's neck in a manner effective to alleviate obstruction of the patient's airway. One mode of implementing this invention, i.e., the application of a pressure less than ambient pressure, is clearly disclosed. This was the best mode contemplated for distending the frontal portions of the patient's neck. It is also possible for one skilled in the art to determine other modes of accomplishing this neck distending function without undue experimentation. Thus, the application requirements have been met.

Once the application requirements are met, the prior art must then be reviewed to determine whether the claimed invention meets the requirements of 35 U.S.C. §§ 102 and 103. This is the task of the U.S. Patent & Trademark Office. In short, the prior art determines what the scope of the claims should be, so long as the application requirements, i.e., the requirements under 35 U.S.C. § 112, are met.

Applicant further notes that claims 4-9 would have been examined if they had been presented in the original filing of the '878 patent, because there is nothing in the U.S. patent law that prevents an applicant from presenting a claim having a scope beyond that which is disclosed in the specification. This can be appreciated by considering the following example.

If a patent application discloses a first member coupled to a second member and only illustrates a screw as the device that joins these two members, is there anything that prevents the applicant from claiming the invention as a first member, a second member, and a *fastener* joining the first member and the second member? Clearly, the answer is no. However, if the Examiner's position in the present application is adopted, the answer would have to be yes, and an absurd result would be reached. For example, future patent applicants would be forced to disclose each and every possible type of fastener in order to prevent the Patent Office from rejecting the application as claiming subject matter beyond that disclosed. For good reason, there is no such burden imposed on patent applicants, and the Examiner's position is not correct. All that is required of an applicant, is to disclose the best mode, nothing more.

B. No indication of Lack of Deceptive Intent

The Examiner alleges that the reissue oath/declaration fails to indicate that the errors arose without any deceptive intention on the part of the applicant. Applicant respectfully disagrees.

The Examiner's attention is directed to Part 4 of the Declaration of Dr. Mark Sanders. In this section, the inventor states, "I believe patent 5,343,878 to be partly inoperative because of error *which occurred without any deceptive intention*, by reason of my having claimed less than I had a right to claim, and by reason of the U.S. Patent & Trademark Office having erroneously identified the inventive entity on the face of the patent." (emphasis added). Applicant submit that this language indicates that the error being corrected by the reissue application arose without any deceptive intent. Although this language is not identical to the language suggested on page 1400-24 of the M.P.E.P, applicant submits that it nevertheless satisfies the reissue oath/declaration requirements. Applicant is prepared to submit a supplemental oath/declaration if the Examiner disagrees.

For the reasons presented above, applicant respectfully submits that the reissue oath/declaration is not defective. Accordingly, applicant respectfully request that the rejection of claims 1-9 be withdrawn.

III. Correspondence Address, Power of Attorney

The following forms, executed by an authorized office of the Assignee, are attached:

- 1) Revocation of Power of Attorney or Authorization of Agent;
- 2) Statement Under 37 C.F.R. § 3,73(b); and
- 3) Power of Attorney or Authorization of Agent.

The forms are submitted for the purpose of revoking all prior powers of attorney or authorizations of agent and appointing the undersigned applicant's representative power of attorney for this application. In addition, these forms are submitted to change the correspondence address for the present application to the address associated with Customer No. 30031, which is also given below. Please note that the Power of Attorney form also requests that the Patent

SANDERS -- Appln. No.: 09/473,196

Application Information Retrieval (PAIR) system be updated to include the present application with this customer number so that its status can be monitored on-line.

All objections and rejections have been addressed. It is respectfully submitted that the present application is in condition for allowance and a Notice to the effect is earnestly solicited.

Respectfully submitted,

By Michael W. Haas

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Attached: 1) Copy of Filing Receipt;
 2) Revocation of Power of Attorney or Authorization of Agent;
 3) Statement Under 37 C.F.R. § 3,73(b); and
 4) Power of Attorney or Authorization of Agent.



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APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/473,196	12/13/1999	3764	760	4077-DIV-REI	2	9	3



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CONFIRMATION NO. 9700
FILING RECEIPT



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Date Mailed: 06/26/2001

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Mark H. Sanders, Wexford, PA;

Domestic Priority data as claimed by applicant

THIS APPLICATION IS A CON OF 08/702,107 08/23/1996 ABN
 WHICH IS A REI OF 08/069,739 06/01/1993 PAT 5,343,878
 WHICH IS A DIV OF 07/895,225 06/08/1992 PAT 5,222,478

Foreign Applications

If Required, Foreign Filing License Granted 02/09/2000

Projected Publication Date: N/A

Non-Publication Request: No

Early Publication Request: No

Title

PRESSURE APPLICATION METHOD

Preliminary Class

128

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